

1 REMARKS

2 Status of the Claims

3 Claims 1-18, 20, 22-30, 32-41, and 45-47 are pending in the present application,
4 Claims 19, 31, and 48 having been cancelled in the present amendment, and Claims 21, 42, 43,
5 and 44 having been previously cancelled. Claims 1, 2, 6, 8, 20, 32, 35, 45, 46, and 47 have been
6 amended to more clearly distinguish over the prior art.

7 Entry of the Present Amendment

8 37 C.F.R § 1.114 indicates that after the filing of a Notice of Appeal, and prior to a decision
9 on the appeal, a Request for Continued Examination will be treated as a request to withdraw the
10 appeal and to reopen prosecution of the application before the Examiner. Applicants hereby
11 affirmatively request that this application be withdrawn from appeal and that prosecution be reopened
12 before the Examiner.

13 Interview with the Examiner

14 On November 16, 2004 Philip Reay (inventor) and Bruce Mitchell (CEO of Onadime, Inc.,
15 the assignee) met with Examiner Naeem Haq and Supervisory Examiner Wynn Coggins to discuss
16 the prior art, which had been cited in this application, in connection with the claims in the case.
17 Phillip Reay and Bruce Mitchell were actually present at the meeting, and applicants' attorney
18 participated in the interview via telephone. Applicants wish to thank the Examiners for their helpful
19 participation in this interview.

20 In discussing the prior art, it was agreed on by the participants in the interview that the
21 primary reference (Wiser) discloses enabling playback of a music file in a full mode as long as the
22 player program has access to a purchaser's private key (incorporated into a passport resident on the
23 player program) and to a media key. The media key is sent to the purchaser during a network
24 transaction in which the music file and the media key are transmitted to the purchaser as a single
25 entity (that entity being referred to as a media file). If playback of the media file is attempted without
26 access to the purchaser's private key (for example, if the purchaser gives that media file to a friend),
27 the music file portion of the media file will only be played in a demo mode, even if the media key
28 sent by the network server managing the transaction is present. Because the media key is
29 incorporated into the media file, distributing a copy of the media file will result in distributing the
30 media key as well. Thus, the player program disclosed by Wiser requires at least two pieces of data

1 (the media key incorporated into the media file, and the purchaser's private key) to enable playback
2 of the music file portion of the media file in a full mode. Only one of those items, the media key, is
3 sent to the purchaser during a purchase transaction. In contrast, in the present claimed invention, the
4 network server transmits a registration value to the purchaser's player program during a network
5 purchase transaction. The presence of that registration value alone controls the playability of a
6 softgood such as a music file. Thus, in the present invention, playability of the softgood by a player
7 program is controlled by the presence or absence of a registration value, which is sent in its entirety
8 to a purchaser during a network transaction.

9 The Examiner noted that because the specification in the present application disclosed that the
10 registration value could be generated using a plurality of different inputs (the Examiner is correct that
11 the identification of the softgood itself, the identification of the player program, and the identification
12 of the purchaser can be combined to generate the registration value), he interpreted Wiser's
13 combination of a media key and a private key as being equivalent to applicants' recited registration
14 value. The Examiner agreed in principle that if applicants' registration value was more narrowly
15 defined to make it clear that the registration value in its entirety was transmitted from a network
16 server to a purchaser during a network transaction, such a registration value would distinguish over a
17 combination of Wiser's media key (which is transmitted to a purchaser during a network purchase
18 transaction) and Wiser's private key (which is resident on the purchaser's player program and is not
19 transmitted to the purchaser during a purchase transaction).

20 Applicants agreed to file a Request for Continued Examination, and to submit concurrently
21 therewith an amendment more clearly defining a registration value consistent with the above
22 discussion. Once again, applicants wish to thank the Examiners for the opportunity to meet with
23 them (both in person and on the telephone) to discuss the prior art and claims.

24 Drawing Objections

25 FIGURES 5 and 6 have been amended to add the "PRIOR ART" legend required by the
26 Examiner. The objection to the drawings should therefore be withdrawn.

27 Claim Objections

28 The Examiner has objected to Claims 2 and 20 because the term "unencrypted softgood"
29 lacks antecedent basis. Claims 2 and 20 have been amended to delete the term "unencrypted." The
30 objection to Claims 2 and 20 should therefore be withdrawn.

1 The Examiner has objected to Claims 19 and 31 under 37 C.F.R. 1.75(c) as being improper
2 dependent claims. Claims 19 and 31 have been cancelled in the present amendment. The objection
3 to Claims 19 and 31 is therefore moot and should be withdrawn.

4 Claims Rejected under 35 C.F.R. § 112

5 The Examiner has rejected Claims 2, 20, 35, and 48 under 35 C.F.R. § 112, first paragraph, as
6 failing to comply with the written description requirement. The Examiner specifically asserts that the
7 description as filed does not describe an “unencrypted” softgood. The term “unencrypted” has been
8 deleted from Claims 2, 20, and 35. Accordingly, the rejection of Claims 2, 20, and 35 under
9 35 C.F.R. § 112, first paragraph, should be withdrawn. Claim 48 has been cancelled. The rejection
10 of Claim 48 is therefore moot and should be withdrawn.

11 The Examiner has rejected Claims 1 and 6 under 35 C.F.R. § 112, second paragraph, as being
12 indefinite. The Examiner asserts that the term “specific” is unclear and has been interpreted to mean
13 “proprietary.” The Examiner’s understanding of the term specific is correct. In an amendment that
14 was filed on September 28, 2004 but not yet entered, applicants replaced the term specific with the
15 term proprietary. That amendment triggered a refusal to enter the amendment, apparently because
16 the term proprietary was not used in the specification as filed. In the present amendment, the term
17 specific has simply been deleted and not replaced with any other. Accordingly, the rejection of
18 Claims 1 and 6 under 35 C.F.R. § 112, second paragraph, should be withdrawn.

19 Wiser’s Player Program

20 As noted above, one of the primary references is U.S. Patent No. 6,385,596 (Wiser). The
21 following provides a brief summary of the player program, public and private keys, media keys, and
22 media files disclosed by Wiser.

23 The player program described by Wiser controls playback of softgoods by determining if the
24 softgood has access to both a media key and private key required to decrypt portions of a softgood.
25 The specific softgood described by Wiser is referred to as a media file, and the media files described
26 by Wiser include demo portions, which can be played without decryption, and full mode portions,
27 which require decryption for playback. The player program described by Wiser is configured to
28 display a purchaser’s passport information (the purchaser’s passport includes the purchaser’s private
29 key, and other personal information, such as the credit card number of the purchaser) when the full
30 mode portion is decrypted and played. Thus, legitimate purchasers are inhibited from providing third

1 parties with their private key (which is required for playback of the softgood in the full mode),
2 because their private key cannot be readily separated from their credit card data (i.e., from their
3 passport). If the legitimate purchaser provides a copy of the media file (including the media key) to a
4 third party without also providing his or her private key (i.e., their passport), then a player program
5 on a different computing system, lacking the purchaser's private key, can only access the demo
6 portion of the media file.

7 The media file disclosed by Wiser is graphically illustrated in FIGURE 2 of Wiser's
8 disclosure. A portion of the media file labeled clip and song information 214 corresponds to the
9 demo portion of the media file, which can be played without having the media key and private key
10 required for decryption of the full mode portion (see column 7, lines 55-62). Also referring to
11 FIGURE 2, the full mode portion of the media file corresponds to audio image 208 (see column 7,
12 lines 4-46). The encryption of the audio image is fairly complex (see the portion of Wiser's
13 disclosure entitled Purchase, column 16, line 26 through column 20, line 7). Each audio image
14 requires a specific media key for decryption of the audio image, the media key being used by Wiser's
15 player program to decrypt the audio image. Rather than the media key being static for each copy of a
16 specific media file, the media key is different for each individual purchaser of the same media file.
17 Essentially, once a consumer has initiated a purchase of a particular media file, the distribution
18 system disclosed by Wiser encrypts the media key for the media file that the consumer wishes to
19 purchase, using the consumer's public key. Wiser's distribution system then sends the media file to
20 the purchaser, the media key being incorporated into the media file (see column 4, lines 4-7, and
21 column 4, lines 36-39).

22 Significantly, only player programs having access to two specific data objects (a media key
23 encrypted with the purchaser's public key, and the purchaser's private key) will be able to playback
24 the media file in the full mode. To playback the media file in the full mode, Wiser's player program
25 uses the consumer's private key to decrypt the media key and then uses the media key to decrypt the
26 audio image. If the player program is unsuccessful in decrypting the audio image, the player program
27 uses the song and clip information 214 to enable preview of the media file. Wiser teaches that the
28 media key is incorporated into the media file (see column 4, lines 4-7, and column 4, lines 36-39) and
29 does not teach or suggest distributing the media key separately from the media file. It is important to
30 note that the purchaser's private key (which is required to enable playback in a full mode) is not

1 transmitted by a network server to the player program during a network purchase of the media file.
2 The only data transmitted from the network server to the player program after a purchase has been
3 made during a purchase transaction is a media file (including demo clips, encrypted audio images,
4 and a media key encrypted using the purchaser's public key, so that the purchaser's private key is
5 required to playback the audio image).

6 Rejection of Claim 1 under 35 U.S.C. § 103 over Wiser in View of APA

7 The Examiner has rejected Claim 1 under 35 U.S.C. § 103(a) as being obvious over Wiser in
8 view of applicants' admission of prior art (APA). The Examiner asserts that Wiser discloses each
9 element recited in applicants' claims, except for distributing the player program to prospective
10 purchasers and argues that such distribution would have been obvious to one of ordinary skill in the
11 art in view of the APA. Applicants have amended Claim 1 to more clearly distinguish over the cited
12 art.

13 As amended, Claim 1 recites that the registration value (which is used to enable playback of a
14 softgood in a full mode) is transmitted *in its entirety and independently of the softgood* from the
15 server to the purchaser during a network purchase transaction. Claim 1 has been further amended to
16 make it clear that the registration value is the *only* data required by the player program to enable
17 playback of the purchased softgood in the full mode. As noted above, the player program described
18 by Wiser requires both the media key (which *is* transmitted to the player program from the network
19 server during a purchase transaction) and the purchaser's private key (which *is not* transmitted to the
20 player program from the network server during a purchase transaction; the private key being part of
21 the passport incorporated into the player program when the purchaser signs up for the network
22 service prior to implementing any purchase transactions). Clearly, the registration value defined in
23 applicants' claim is not equivalent to Wiser's media key, and the combination of Wiser's private key
24 and Wiser's media key is not equivalent to applicants' registration value, because only part of that
25 combination is transmitted to the purchaser from the network server during a network purchase
26 transaction, and the part that is transmitted is not functionally equivalent to applicants' registration
27 value.

28 It is true that both Wiser's distribution system and applicants' invention, as defined in
29 Claim 1, facilitate the distribution of softgoods, where such softgoods can be played in a demo mode
30 or in a full mode based on evidence proving purchase of the softgood. Significantly, however,

1 applicants' claimed invention achieves the proof function in an entirely different manner than Wiser.
2 Applicants' claimed invention requires only that a registration value be accessible on the computer
3 used to access the softgood, as opposed to a media key and private key combination, as taught by
4 Wiser.

5 It may be useful to review how a player program residing upon a third party's computer will
6 access a softgood that has been given to the third party by a legitimate purchaser – in both Wiser and in
7 accord with the invention of applicants' Claim 1. According to Wiser, the player program residing on
8 the third party's computer will attempt to decrypt the full mode portions of the softgood given to the
9 third party by the legitimate purchaser. Assuming that the legitimate purchaser has not also given
10 his/her private key to the third party, the player program on the third party's computer will not be able
11 to decrypt the full mode portions of the softgood, because without the legitimate purchaser's private
12 key, the media key required to decrypt the audio image cannot be decrypted. Thus, the player program
13 on the third party's computer, even though it has a copy of the media key (the media key being
14 incorporated in Wiser's media file and thus moved with the media file from one computer to a second
15 computer), will not be able to play the softgood in the full mode. If Wiser's media key is equivalent to
16 applicants' registration value, moving the media file from a first computer to a second computer would
17 enable playback in the full mode without anything further being required. Significantly, for the third
18 party to receive a copy of the media file specifically licensed to the third party, the third party must
19 receive a *new* copy of the media file, a media file that includes a media key specifically encrypted to his
20 or her public key, to be able to access the full mode portions of the softgood.

21 In contrast, according to the method defined in Claim 1, when a legitimate purchaser gives a
22 copy of a softgood to a third party, the player program on the third party's computer will recognize
23 that no registration value has yet been provided to the third party's computer. The third party's
24 player program will only allow access to the softgood in the demo mode. If the third party desires to
25 have full access to the softgood, the third party must initiate a network transaction with applicants'
26 server. Note that applicants' server will not need to send an entire new copy of the softgood to the
27 third party. Instead, applicants' server simply sends the third party a registration value that is then
28 stored on the third party's computer. As long as the third party's computer has a registration value
29 corresponding to the softgood in question, the player program residing on the third party's computer
30 will allow the softgood to be accessed in a full mode.

1 Applicants believe that the distribution system described in Claim 1 is as secure as the
2 distribution system described by Wiser, without requiring the substantial server overhead required by
3 Wiser's system (Wiser's server encrypts a media key specific to each purchaser and then transmits a
4 softgood to *each* purchaser). Applicants' distribution service is much simpler to implement from the
5 server side, yet still offers security to protect against unrestricted file sharing across peer-to-peer
6 networks (because softgoods traded across such file sharing networks will only be playable in a demo
7 mode until each recipient of such a softgood contacts the e-commerce agency to pay for the softgood
8 and receive a registration value). In fact, in the paradigm of the present invention, peer-to-peer
9 networks are simply an additional beneficial distribution mechanism. Furthermore, Wiser's player
10 program must perform significantly more processing to playback a softgood, because the player
11 program must first use the purchaser's private key to decrypt the media key, then use the media key
12 to decrypt the audio images, for each media file, each time that media file is accessed. Applicants'
13 invention as defined by Claim 1 does achieve similar results, but in a very different and more
14 computationally efficient manner.

15 It should be noted that Wiser does not teach or suggest sending a media key independently of
16 the media file. Wiser clearly discloses that the media key is incorporated into the media file, as
17 opposed to being sent to the purchaser independently of the media file. Note that if a prospective
18 purchaser already had a copy of the media file, and Wiser's system were modified so that only a
19 media key encrypted using the prospective purchaser's public-key was sent to the prospective
20 purchaser after purchase (as opposed to sending a new media file including a media key encrypted
21 using the prospective purchaser's public-key), Wiser's player program would need to be modified
22 such that the player program could extract an old media key (i.e., a media key that does not
23 correspond to the prospective purchaser) and replace the old media key with a new media key
24 encrypted using the prospective purchaser's public-key. While such a modification might be
25 technically feasible, the cited art does not teach or suggest this modification, or provide any guidance
26 as to how such a modification could be implemented. Significantly, even if Wiser's media file
27 distribution system were modified so that if a prospective purchaser already possessed a copy of the
28 media file, the network server would simply send a media key encrypted with the prospective
29 purchaser's public-key after purchase had been made, that media key still would not enable playback
30 in the full mode *without* the prospective purchaser's private key. Thus, such modifications still would

1 not achieve an invention equivalent to that claimed by the applicants, because the media key, even if
2 sent independently of the media file, is not the only data required to enable playback in the full mode.
3 Specifically, the purchaser's private key, which is not transmitted during the purchase transaction, is
4 still required.

5 Applicants' registration value is also not equivalent to Wiser's media key because the media
6 key alone will not enable playback of the softgood in the full mode, without the corresponding
7 private key. Wiser's media key and private key cannot be considered in combination to be equivalent
8 to applicants' registration value, because applicants specifically recite that the registration value is
9 transmitted from an e-commerce server to a purchaser during a purchase transaction, *in its entirety*
10 *and independently of the softgood*. The private key disclosed by Wiser is part of a passport that
11 resides on a player program once a user is registered with Wiser's distribution system and installed
12 the player program. The private keys are not distributed as part of a purchase transaction and thus,
13 cannot logically be considered to be a registration value. Applicants' invention and Wiser's system
14 may achieve similar results, but they do so in distinguishably different ways. The cited art does not
15 teach or suggest the modifications required for Wiser's system to be made equivalent to applicants'
16 claimed invention. Accordingly, the rejection of Claim 1 as being obvious over Wiser, in view of
17 APA, should be withdrawn. Because dependent claims are patentable for at least the same reasons as
18 the claims from which they depend, each claim depending on Claim 1 is also patentable for the same
19 reasons that it is. Accordingly, the rejection of Claim 2-7 as being obvious over Wiser, in view of
20 APA (and other cited art), should also be withdrawn.

21 Rejection of Claim 2 under 35 U.S.C. § 103 over Wiser in view of APA and Rinearson

22 The Examiner has rejected Claim 2 under 35 U.S.C. § 103(a) as being obvious over Wiser in
23 view of applicants' APA, and further in view of Rinearson. The Examiner admits that Wiser and the
24 APA do not teach or suggest that the unique identifier for each softgood also references a unique
25 identifier of the specific copy of the program provided to the creator to generate the softgood. The
26 Examiner notes that Rinearson discloses a software application (MS Word) that adds the file
27 extension "*.doc" to each document generated with the software. The Examiner asserts that the file
28 extension is equivalent to adding a unique identifier of the program used to generate the softgood.

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1 While the Examiner admits that the cited art does not teach that the unique identifier for each
2 softgood references the *specific copy* of the creator program used to generate the softgood from all
3 other copies of the creator program, the Examiner has not afforded any weight to such language. The
4 Examiner asserts that such language is merely descriptive. Applicants respectfully submit that such
5 language is not merely descriptive and have been included structure in the claims that more clearly
6 support this position. The creator program is clearly encompassed in the scope of the invention. In
7 rejecting Claim 1, the Examiner has indicated that he understands that the creator program includes a
8 unique identifier in each softgood that is generated. Claim 2 simply further defines the invention, so
9 that the unique identifier must specifically identify the *specific copy* of the creator program used to
10 generate the softgood. While the Examiner may believe that applicants *could* have used better
11 language to recite such a limitation, the Examiner clearly understands the requirement that applicants
12 have recited within Claim 2. There appears to be no reasonable basis to refuse to provide such a
13 definition any patentable weight, particularly where the Examiner clearly understands the intent and
14 meaning of the recitation and has admitted that the cited art does not teach or suggest such a feature.
15 USPTO policy and procedure clearly favors providing an applicant wide latitude in drafting claims,
16 recognizing the inherent impreciseness of language. In this instance, the language applicants have
17 employed clearly *has been understood* by the Examiner, and just as clearly, this language
18 distinguishes over the cited art. It is unreasonable to reject such a claim simply because the Examiner
19 believes applicants should have structured the claim in a different manner. For this additional reason,
20 the rejection of Claim 2 should be withdrawn.

21 Rejection of Claim 8 under 35 U.S.C. § 103 over Wiser in view of APA

22 The Examiner has rejected Claim 8 under 35 U.S.C. § 103(a) as being unpatentable over
23 Wiser in view of applicants' APA, and further in view of Official Notice. The Examiner asserts that
24 Wiser discloses each element of applicants' claim, except for prospective purchasers having a
25 complete copy of a softgood prior to purchase, and that the purchase is implemented from within the
26 player program. Applicants have amended Claim 8 to further distinguish over the cited art.

27 Claim 8 has been amended to recite that the registration value is sent by the e-commerce
28 agency to a purchaser *in its entirety and independently of the softgood*. Further, the registration value
29 is the *only* data required to enable playback of the softgood in the full mode. As discussed above in
30 detail, Wiser specifically teaches that the media key encrypted using a purchaser's public key is

1 incorporated into the media file being purchased before being transmitted to the purchaser, and that
2 the media key alone does not enable playback in the full mode (the purchaser's private key is also
3 required, and the purchaser's private key is not part of the data transmitted during the purchase
4 transaction). Claim 8 is therefore patentable for substantially the same reasons as discussed above
5 with respect to the rejection of Claim 1.

6 Yet another distinguishing element not taught or suggested by the prior art is the softgood
7 registration file defined in Claim 8, which specifically recites that each registration value received in
8 a network transaction is added to a *softgood registration file* stored on the computing system
9 communicating with the e-commerce agency. Wiser does not teach or suggest any data structure
10 stored on the computing system (where the player program is executing) in which each registration
11 value received by the computing system during a network transaction for purchasing a softgood is
12 stored, or do any of the other cited references. Wiser teaches a transaction ID that is appended to
13 each media file, but does not teach or suggest combining data from different media files into a single
14 file. The cited art simply does not teach or suggest modifying Wiser's distribution system to
15 implement a step of creating a softgood registration file in each computing system upon which a
16 player program resides, or the step of adding to that registration file each registration value received
17 by that computing system during the purchase of a softgood. Note that utilizing the terms employed
18 by Wiser; such a registration file would include media keys for each media file purchased (as well as
19 the private key required to decrypt the media keys). Accordingly, there appears to be no reasonable
20 basis for modifying Wiser to achieve such a data structure.

21 With respect to the Examiner's comments regarding downloading an entire media file
22 onto a potential purchaser's computing system, such that Wiser's distribution system would need
23 only send a media key after purchase, rather than requiring the prospective purchaser to
24 download a second entire copy of the media file (including the media key customized to the
25 purchaser's public key), the cited art provides no guidance to one of ordinary skill in the art as to
26 how a media key sent independently of a media file could be properly matched to the
27 corresponding media file. Even should one of ordinary skill in the art be able to modify Wiser to
28 enable media keys sent independently of media files to be properly matched to the correct media
29 file, such a modification would still not achieve an invention equivalent to applicants' claimed
30 invention, because (as discussed in detail above) Wiser's media keys alone do not enable

1 playback of media files in the full mode; instead, the user's private key is also required (note the
2 purchaser's private key is not transmitted during a purchase transaction, as is applicants'
3 registration value).

4 Finally, Claim 8 specifically recites that the purchaser is able to initiate a purchase
5 transaction *from within* the player program. The Examiner has asserted that modular programming
6 techniques could be used to implement such functionality, and that by virtue of Official Notice,
7 such modular programming is prior art. Regardless of whether modular programming is prior art,
8 or whether modular programming could be used to implement such a functionality, there is simply
9 no evidence that one of ordinary skill in the art would have been motivated to modify Wiser's
10 player program so that a network transaction could be implemented from *within* Wiser's player
11 program. There is no evidence that such a modification would solve any problem recognized in the
12 art. The Examiner has not provided any evidence of any player program implementing such
13 functionality or any prior art suggesting such a modification. Simply because such functionality
14 conceivably could be implemented using modular programming, absent other evidence about how
15 such a modification could be made or any indication motivating one of ordinary skill to make the
16 modification, the Examiner is not justified in concluding that such a modification would indeed
17 have been obvious.

18 The Examiner has asserted that modifying Wiser's player program to enable network
19 transactions to be implemented from within the player program, rather than being implemented in
20 a network browser, simply represents integrating a plurality of modules into a single module, and
21 that making something integral in this manner is within the ordinary level of skill in the art.
22 Significantly, the cited art does not teach or suggest that a player program would benefit from
23 being thus modified to provide the additional functionality of being able to implement a purchase
24 transaction from within the player program. Furthermore, the case law to which the Examiner
25 cites (for example, *In re Larson*, see MPEP 2144.04) relates to physical structures, where the
26 function of the prior art structure and the new structure are identical. In such a circumstance, the
27 Examiner may be correct that making a multi-piece structure as an integral structure is generally
28 not inventive (however, where there is some difference in functionality between the two
29 structures, novelty can exist, as noted in this case law cited by the Examiner). However, with
30 respect to applicants' claimed invention, the player program defined in applicants' Claim 8

1 provides a function not provided by the prior art player program. Thus, the modification
2 suggested by the Examiner is not simply a choice of engineering design. There appears no basis
3 to conclude that the case law cited by the Examiner is intended to be applied to methods that
4 accomplish different functions.

5 In summary, applicants' invention as defined by Claim 8 is distinguishable over the cited art
6 because Wiser's media keys are not equivalent to applicants' registration values, because Wiser does
7 not teach the step of adding a registration value for each softgood purchased to a registration file on
8 the purchaser's computer, and because Wiser's player program does not enable implementing
9 network transactions from within the player program itself. None of the other art cited by the
10 Examiner, alone or in combination, teaches or suggests the modifications required to Wiser to
11 achieve an equivalent invention. Dependent claims are patentable for at least the same reasons as the
12 claims from which they depend; thus, each claim depending on Claim 8 is also patentable for the
13 same reasons as it is. Accordingly, the rejection of Claims 8-18 as being obvious over Wiser in view
14 of APA and Official Notice should be withdrawn.

15 Rejection of Claim 20 under 35 U.S.C. § 103 over Ronning & Richardson in view of Official Notice

16 The Examiner has rejected Claim 20 under 35 U.S.C. § 103(a) as being obvious over U.S.
17 Patent No. 5,883,955 (Ronning) in view of Official Notice, and further in view of U.S. Patent
18 No. 5,490,216 (Richardson). Applicants have amended Claim 20 to more clearly distinguish over the
19 cited art.

20 As amended, Claim 20 recites that the registration value is transmitted from a network server
21 to a purchasing computer during a purchase transaction. Further, the registration value is transmitted
22 *in its entirety and independently of the softgood*. Further, Claim 20 defines that the registration value
23 is the *only* data required to enable playback in the full mode.

24 Ronning discloses sending encrypted digital data (such as software or softgoods) over a
25 network. Before purchase the softgood can be previewed in a demo mode, using a user interface
26 designed to enable prospective purchasers to interact with the distribution system. FIGURE 3 of
27 Ronning's disclosure illustrates an exemplary user interface. It appears that until a purchase has
28 been consummated, this user interface is required to preview a softgood. According to Ronning,
29 it is the presence or absence of an envelope that encloses a softgood (see FIGURE 2 of Ronning's
30 disclosure) that controls whether the softgood is playable in a full mode or in a demo mode.

1 After the softgood is purchased, a copy of the software or softgood without the envelope is made
2 available to the purchaser (column 3, lines 44-48). Significantly, as amended, Claim 20 recites
3 that the player program is enabled to playback a softgood in a full mode by a registration value
4 that is transmitted during a purchase transaction, *in its entirety and independently of the softgood*.
5 Ronning teaches that after a purchase, an unlocked copy (i.e., a copy without the protective
6 envelope) is transmitted to the purchaser. Transmitting an unlocked copy is not equivalent to
7 transmitting a registration value that is sent independently of a softgood for which the registration
8 value is to be used.

9 Further, note that once the purchaser has a copy of the software or softgood without the
10 envelope, the user interface shown in FIGURE 3 is no longer required. If the digital data purchased
11 is a software program, that software program can be installed on any computing device desired. If
12 the digital data purchased is a softgood, then that softgood can be played using a compatible player
13 program. Ronning does not teach or suggest that the user interface shown in FIGURE 3 is required
14 or used for *playback of a softgood after purchase*. That is, there is no basis for concluding that
15 Ronning's user interface is equivalent to applicants' player program, because there is no evidence
16 that Ronning's user interface is used to play the softgood in a full mode once the softgood has been
17 purchased and a copy of the softgood absent the envelope is sent to the purchaser. It appears that the
18 user interface shown in FIGURE 3 simply enables a prospective purchaser to sample a software
19 product or softgood while it is protected in the envelope shown in FIGURE 2 (i.e., the user interface
20 is for preview sampling only). Once the purchaser has a copy of the digital data without the
21 envelope, the purchaser has a software product or softgood that is used *independently* of the user
22 interface.

23 In contrast, Claim 20 recites a player program that is used to play back a softgood both in
24 a demo mode before purchase and *in a full mode after purchase*. The user interface disclosed by
25 Ronning in FIGURE 3 is not equivalent to applicants' recited player program, because Ronning's
26 user interface is not used with software or softgoods that have been purchased. Claim 20
27 specifically recites that if a particular softgood is registered on the computer on which the player
28 program is installed, the player program enables playback of the particular softgood in full mode.
29 Claim 20 also recites that the player program is configured to determine if they softgood is
30 registered on the computer before enabling playback of the softgood. Based on Ronning's

1 disclosure, the user interface shown in FIGURE 3 is only used if the softgood or software has not
2 yet been purchased (i.e., is not yet registered). After purchase, the user interface shown in
3 Ronning FIGURE 3 is not used to play a softgood in a full mode. Thus, Ronning's user interface
4 does not determine if a softgood has been registered. None of the art cited by the Examiner,
5 alone or in combination, suggests a player program that controls playback in both a demo mode
6 and a full mode based on the presence or absence of a registration value. Accordingly, the
7 combination suggested by the Examiner does not achieve an invention equivalent to applicants'
8 claimed invention.

9 Further, Claim 20 specifically recites that each registration value received in a transaction is
10 added to a softgood registration file stored on the computing system on which the player program is
11 installed. The art cited by the Examiner does not teach or suggest such a softgood registration file.
12 Ronning does not teach or suggest any data structure stored on the computing system (where the
13 player program is executing) for storing each registration value received by the computing system
14 during a transaction for purchasing a softgood. The cited art thus does not teach or suggest
15 modifying Ronning's distribution system to implement applicants' step of creating a softgood
16 registration file in each computing system upon which a player program resides, or the step of adding
17 to that registration file each registration value received by that computing system during the purchase
18 of a softgood.

19 Applicants' invention as defined by Claim 20 is distinguishable over the cited art because the
20 combination of references suggested by the Examiner does not achieve an equivalent player program,
21 which enables playback of the softgood in a full mode using a registration value that is sent
22 independently of the softgood, by determining if the registration value is present in a softgood
23 registration file, and which enables preview and purchase of a softgood from within the player
24 program. Dependent claims are patentable for at least the same reasons as the claims upon which
25 they depend; thus, each claim depending from Claim 20 is patentable for at least the same reasons as
26 it is. Accordingly, the rejection of Claims 20-30 as being obvious in view of Ronning and the other
27 cited art should be withdrawn.

28 Rejection of Claim 32 under 35 U.S.C. § 103 over Wiser in view of APA and Official Notice

29 The Examiner has rejected Claim 32 under 35 U.S.C. § 103(a) as being unpatentable over
30 Wiser in view of applicants' APA, and further in view of Official Notice. The Examiner asserts

1 that Wiser discloses each element of applicants' claim, except for prospective purchasers having a
2 complete copy of a softgood prior to purchase, and that the purchase is implemented from within
3 the player program. Applicants have amended Claim 32 to more clearly distinguish over the cited
4 art.

5 As amended, Claim 32 similarly recites that the registration value is transmitted from a
6 server during a purchase transaction *in its entirety and independently of the softgood*, and that it is
7 the presence of the registration value *alone* (and no other additional data) that determines whether
8 the softgood can be played back in a full mode. As discussed above in detail with respect to the
9 rejection of Claim 1, Wiser alone or in combination with any of the cited art, does not teach or
10 suggest a registration value that controls playability of the softgood without requiring the use of
11 additional data (i.e., the purchaser's private key), wherein the registration value is transmitted in its
12 entirety from a server during a purchase transaction, such that the registration value is transmitted
13 in its entirety and independently of the softgood.

14 Further, Claim 32 recites a data structure referred to as a registration file that is resident on
15 a purchaser computer. The references cited by the Examiner, either alone or in combination, do not
16 teach or suggest an equivalent data structure. Finally, Claim 32 also recites that the player program
17 residing on the purchaser computer enables a purchase transaction to be implemented using the
18 player program. This recitation defines a function that the prior art does not teach or suggest is
19 associated with a player program, and any modification of prior art player programs to include this
20 function would require much more than simply making known elements integral, as discussed in
21 detail above. For these reasons Claim 32 defines a novel invention. Dependent claims are
22 patentable for at least the same reasons as the claims from which they depend, thus each claim
23 dependent upon Claim 32 is also patentable for the same reasons. Accordingly, the rejection of
24 Claims 32-34 as being obvious over Wiser in view of APA should be withdrawn.

25 Rejection of Claim 35 under 35 U.S.C. § 103 over Wiser in view of APA and Official Notice

26 The Examiner has rejected Claim 35 under 35 U.S.C. § 103(a) as being unpatentable over
27 Wiser in view of applicants' APA, and further in view of Official Notice. The Examiner asserts
28 that Wiser discloses each element of applicants' claim, except for prospective purchasers having a
29 complete copy of a softgood prior to purchase, and that the purchase is implemented from within
30 the player program. Applicants have amended Claim 35 to more clearly distinguish over the cited

1 art.

2 As amended, Claim 35 recites a player program that selects a mode of play (e.g., full versus
3 demo) based on the presence of a registration value that is transmitted over a network to a
4 purchaser's computer after a purchase transaction, *in its entirety and independently of the softgood*.
5 As discussed in greater detail above, Wiser teaches a media key that is incorporated into a media
6 file that is transmitted to a purchaser after a purchase transaction. The media key is used along
7 with the purchaser's private key (the purchaser's private key not being transmitted during a
8 purchase transaction) to enable playback of the media file in a full mode. In applicants' invention,
9 the registration value (transmitted during a purchase transaction) *alone* enables playback of the
10 softgood in the full mode. Clearly Wiser's media keys are not equivalent to applicants' registration
11 values, and the references cited by the Examiner, either alone or in combination, do not teach or
12 suggest modifying Wiser's media keys to achieve a registration value that is transmitted
13 independently of the softgood and which alone enables playback in a full mode.

14 Claim 35 is further distinguishable over the combinations of references cited by the
15 Examiner, because the server computer operated by the e-commerce agency defined in Claim 35 is
16 configured to receive a unique identifier for a softgood from *a user of the softgood at a time of sale*
17 *of the softgood*. Wiser does teach that creators of softgoods can include identifiers in the softgoods
18 at the time the softgoods are created. According to Wiser's distribution model, however, those
19 softgoods (and their unique identifiers) will be included in a database operated by the online
20 distribution service only if the creator of the softgood interacts with the online distribution service.
21 FIGURE 1B of Wiser's disclosure clearly shows authoring tool 102 communicating with music
22 distribution center 124 via licensing center 110, content manager 112, or distribution hub 104.
23 Applicants' system as defined in Claim 35 enables the unique identifier of a softgood to be
24 communicated to the distribution service at the time of purchase *by the user of the softgood*, as well
25 as by the creator of the softgood communicating with the online distribution service (page 8,
26 lines 24-29; see also blocks 118 and 120 of FIGURE 4).

27 As explained in applicants' specification as filed, applicants have contemplated that not
28 only could softgoods be distributed online by an e-commerce agency under contract with the
29 creator of the softgood, but in addition, softgoods could be physically distributed by the creator
30 independently of the e-commerce agency. Thus, the creator of a softgood could bypass the online

1 distribution service and distribute his or her softgoods directly to a potential audience (or via the
2 creator's own website, as opposed to the online distribution service's location). For example, a
3 local music act could distribute softgoods (i.e., their music on compact discs) at their shows. In
4 such a distribution model, the compact disc would also include a copy of the required player
5 program (page 8, line 30 to page 9, line 5). When the recipient of such a disc attempted to play the
6 music files contained therein, the player program would recognize that the softgood had not yet
7 been purchased (i.e., that a registration value had not been received from the e-commerce
8 agency/online distribution service). The player program will only enable playback of the music
9 files in the demo mode. Should the recipient wish to purchase the softgood and thereby enable
10 playback in the full mode, the recipient would connect with the online distribution service (i.e.,
11 with the e-commerce agency) to purchase the softgood, and receive the registration value required
12 to enable playback of the softgood in the full mode. Because the creator of the softgood had not
13 yet provided the e-commerce agency with a copy of the softgood, the e-commerce agency would
14 collect the information about the softgood (the identity of the creator, the purchase price the creator
15 desires to receive, and the unique identifier of the softgood) from the softgood being played on the
16 recipient's computer. Wisner simply does not teach or suggest such a distribution model, or does
17 any of the other art cited by the Examiner. Thus, the combination of references suggested by the
18 Examiner does not achieve an equivalent invention, where the server computer operated by the e-
19 commerce agency is configured to receive the unique identifier for a softgood from the user of the
20 softgood at time of sale. Applicants' FIGURE 1A and FIGURE 4 (particularly decision block 120)
21 and the corresponding text in applicants' application describe this distribution process (in which the
22 softgood is directly distributed to users, before the e-commerce agency has received a copy of the
23 softgood for its database).

24 Because the combination suggested by the Examiner does not achieve a registration value
25 that alone controls playback of the softgood in the full mode or demo mode, or an e-commerce
26 server configured to receive unique identifiers associated with a softgood from a user/purchaser of
27 the softgood at the time of sale, Claim 35 defines a patentable invention. Dependent claims are
28 patentable for at least the same reasons as the claims upon which they depend, and therefore, each
29 claim dependent upon Claim 35 is also patentable for the same reasons as it is. Accordingly, the
30 rejection of Claims 35-41 as being obvious over Wisner in view of APA and Official Notice should

1 be withdrawn.

2 Rejection of Claim 45 under 35 U.S.C. § 103 over Wiser in view of APA and Official Notice

3 The Examiner has rejected Claim 45 under 35 U.S.C. § 103(a) as being unpatentable over
4 Wiser in view of applicants' APA, and further in view of Official Notice. The Examiner asserts that
5 Wiser discloses each element of applicants' claim, except for prospective purchasers having a
6 complete copy of a softgood prior to purchase, and that the purchase is implemented from within the
7 player program. Applicants have amended Claim 45 to more clearly distinguish over the cited art.

8 As amended, Claim 45 recites a method for facilitating an automated sale of softgoods, in
9 which the softgoods require a player program to enable access of the softgoods. The method
10 includes the step of distributing the player program to prospective purchasers such that each time
11 the player program is used to play a softgood, the player program automatically checks the
12 computing system on which the specific player program is executing to determine if a registration
13 value corresponding to the softgood has been provided to the computing system (to register the
14 softgood). If so, the player program plays the softgood in a full mode. If a registration value
15 corresponding to the softgood is not found on the computing system on which the player program
16 is executing, the player program enables playback of the softgood only in a demo mode.
17 Significantly, the registration value is transmitted to the player program during a purchase
18 transaction *in its entirety and independently of the softgood*. As discussed in detail above,
19 Wiser's player program requires both media key and a private key to enable playback in the full
20 mode, and only the media keys are transmitted by the e-commerce agency during a purchase
21 transaction. Thus Wiser's media keys are not equivalent to applicants' registration values, and
22 the references cited by the Examiner, either alone or in combination, do not teach or suggest
23 modifying Wiser's media keys to achieve a registration value that *alone* enables playback in a
24 full mode.

25 Because the combination suggested by the Examiner does not achieve a registration value that
26 alone controls playback of the softgood in the full mode or demo mode, Claim 45 recites patentable
27 subject matter. Further, because dependent claims are patentable for at least this same reasons as the
28 claims on which they depend, Claim 46 is also patentable. Accordingly, the rejection of Claims 45
29 and 46 as being obvious over Wiser in view of APA and Official Notice should be withdrawn.

30 Rejection of Claim 47 under 35 U.S.C. § 103 over Wiser in view of APA and Official Notice

1 The Examiner has rejected Claim 47 under 35 U.S.C. § 103(a) as being unpatentable over
2 Wiser in view of applicants' APA, and further in view of Official Notice. The Examiner asserts
3 that Wiser discloses each element of applicants claim, except for prospective purchasers having a
4 complete copy of a softgood prior to purchase, and that the purchase is implemented from within
5 the player program. Applicants have amended Claim 47 to more clearly distinguish over the
6 cited art.

7 As amended, the player program defined in Claim 47 enables playback of a softgood in
8 either a full mode or a demo mode based *only* on the presence of registration value that is
9 transmitted to the player program during a purchase transaction, the registration value being
10 transmitted *in its entirety and independently of the softgood*. As discussed in detail above, the
11 registration value defined by applicants is distinguishable over the private keys and media keys
12 disclosed in the cited art, and the cited art, either alone or in combination, does not teach or
13 suggest modifying Wiser's media keys and private keys to achieve an invention equivalent to
14 applicants' claimed invention.

15 Claim 47 additionally recites machine instructions that implement the function of
16 communicating with the database on the remote computer over the network to determine if an
17 authorized user of the purchaser computer has previously purchased the softgood that is to be
18 played, if a registration value corresponding to the unique identifier of the softgood that is to be
19 played has not been provided to the purchaser computer. If it is determined that an authorized
20 user of the purchaser computer has previously purchased the softgood that is to be played, the
21 machine instructions defining the player program enables playback of the softgood so as to
22 provide access to its full range of benefits.

23 Wiser does not teach a player program that contacts an e-commerce agency to determine if
24 an authorized user of the computer on which the player program resides has previously purchased
25 the softgood to be played. Wiser's player program either has a media key and a private key
26 enabling decryption of the softgood, or Wiser's player program enables only a preview of the
27 softgood. The APA discloses software that is locked or unlocked, and does not indicate or
28 suggest that it is known in the art to contact an e-commerce agency to see if an authorized user of
29 the computer has purchased the softgood. For this additional reason, Claim 47 is distinguishable
30 over the cited art. Accordingly, the rejection of Claim 47 should be withdrawn.

1 In consideration of the preceding remarks and the amendments above, it is apparent that
2 all claims remaining in the present invention define a novel and non-obvious invention.
3 Therefore, the Examiner is requested to pass this case to issue at an early date. In the event that
4 any further questions remain, the Examiner is requested to telephone applicants' attorney at the
5 number listed below.

6 Respectfully submitted,

7
8 
9

10 Ronald M. Anderson
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11 MCK/RMA:lrg

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16 Kathy Paulino

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16 

17 (Signature of person mailing paper or fee)

17 Enclosures

18 Replacement Drawing (Figs. 5-6)

1 **Amendment to the Drawings**

2 **In the Drawings:**

3 Please amend the drawings as follows:

4 Replacement FIGURES 5 and 6 have been amended to include the PRIOR ART legend as
5 required by the Examiner.